

II. Rejection Under 35 U.S.C. § 103

Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,074,438 ("Lim") in view of U.S. Patent No. 5,230,710 ("Akram").

Applicant respectfully traverses this rejection for the reasons of record, as well as those emphasized below.

In response to the statements contained in the Advisory Action, Applicant respectfully submits that no motivation exists in Lim and Akram that would have led one of ordinary skill in the art to make the numerous selections necessary to arrive at the presently claimed invention. Applicant believes that this lack of motivation is magnified when the amendments to the independent claims are taken into account.

Lim discloses a multitude of optional ingredients a vast majority of which fall outside the scope of the present invention. Lim, col. 5-7 (emphasis added). As set forth in the Amendment filed January 31, 2003, this list of optional ingredients contain at least five different classes of dye intermediates and/or couplers. Notably, at least four of these classes contain no ingredients which read on the at least one oxidation base recited in the independent claims.

In order for one of ordinary skill in the art to arrive at the present invention, she would have had to:

- 1) choose to include at least one optional dye intermediate or coupler;
- 2) pick and choose a class of p-aminophenols from among the many classes of dye intermediates and/or couplers disclosed in at least three columns of Lim;
- 3) make a further selection of at least one p-aminophenols that falls within the scope of the presently claimed at least one oxidation base;

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- 4) select a base from the disclosure of Akram that falls within the scope of the claimed invention; and
- 5) make yet another decision to combine the at least one oxidation base selected in step 3) with the base of Akram selected in step 4).

Applicant respectfully submits that guidance to make such numerous selections is not found in either Lim or Akram. The Office has not, and cannot, point to the objective teachings in the references to show the motivation required for establishing a prima facie case of obviousness.

Moreover, Lim is primarily concerned with finding an appropriate pyrazolone coupler to use in its compositions. Lim, col. 4, lines 32-36. Accordingly, Lim '438 teaches a composition comprising a 4-amino-2,6-dichlorophenol (1) and 3-methyl-1-phenyl-2-pyrazolin-5-one. Lim, col. 4, lines 37-39. This composition allowed one to formulate various dye shades without relying on p-phenylenediamine, a coupler used in the prior art. Lim, col. 4, lines 40-43. Thus, any guidance provided by Lim would have been directed to compounds other than the optional dye intermediates and/or couplers.

For at least these reasons, Applicant respectfully request that the Examiner withdraw the rejection.

III. CONCLUSION

Applicant respectfully requests the entry of the proposed Amendment, the reconsideration of this application, and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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